

## **REMARKS/ARGUMENTS**

Claim 49 is pending in the present application. No claims were canceled. Claims 50-51 were added. Claim 49 was amended. Claim 50-51 were added. Reconsideration of the claims is respectfully requested.

### **I. 35 U.S.C. § 103, Obviousness**

The Examiner has rejected claim 49 under 35 U.S.C. § 103 as being unpatentable over Shibuya et al., U.S. Patent Application Publication No. 2004/0064269 (hereinafter Shibuya) in view of Lau et al., U.S. Patent No. 7,191,435 (hereinafter Lau). Final Office Action dated December 15, 2008, pp. 1-5. This rejection is respectfully traversed.

The Examiner bears the burden of establishing a *prima facie* case of obviousness based on the prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 .2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). These reasons are discussed in more detail below.

In *Graham v. John Deere Co. of Kansas City*, 383 U. S. 1 (1966), the Supreme Court set out a framework for applying the statutory language of §103. The Court stated:

Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.

*Id.*, at 17.18.

In other words, these factual inquires include (1) determining the scope and content of a patent claim and the prior art relative to a claim in the application at issue; (2) determine the differences between the scope and content of the patent claim and the prior art as determined in (1); (3) determine the level of ordinary skill in the pertinent art; and (4) evaluate any objective indicia of non-obviousness.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth

in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). Discussing the question of obviousness of a patent that claims a combination of known elements, *KSR Int'l v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007), explains:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *Sakraida v. AG Pro, Inc.*, 425 U.S. 273 (1976)] and *Anderson's-Black Rock[, Inc. v. Pavement Salvage Co.*, 396 U.S. 57 (1969)] are illustrative—a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

*KSR*, 127 S. Ct. at 1740.

If the claimed subject matter cannot be fairly characterized as involving the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement, a holding of obviousness can be based on a showing that “there was an apparent reason to combine the known elements in the fashion claimed.” *Id.* at 1740-41. Such a showing requires some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ. *Id.* at 1741 (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)) (internal quotation marks omitted). If the Examiner’s burden is met, the burden then shifts to the Applicants to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

The Examiner has failed to meet the required burden in the present case. More specifically, the Examiner has failed to demonstrate that the claim limitations are explicitly found in the cited art. The claim limitations are not explicitly found because the art is directed to different actions and the actions that are shown in the prior art cannot be combined to cooperate

in the same way as the limitations of the claims. For example, features are not taught as the Examiner believes in each of the claim limitations. Moreover, the modifications and combinations would not be made when the references are considered as a whole. Each claim limitation is discussed below for claim 49. The arguments presented for claim 49 apply to the new claims as well since the new claims are apparatus and program product claims with similar limitations. No new matter has been introduced.

Claim 49 recites:

A computer implemented method for creating a new return on investment template from a default template and a plurality of modified templates in order to calculate an amount of money a customer will spend for a process upgrade, the method comprising:

- developing a data list from the plurality of modified templates and the modified templates' effectiveness factors, wherein the data in the modified templates is weighted according to the modified templates' effectiveness factors;

- plotting the data list on a histogram, the histogram comprising an orthogonal axis for each parameter in the default template;

- analyzing each parameter by performing steps comprising:

- determining if the histogram contains more than one peak for a parameter;

- responsive to a determination that the histogram contains one peak, updating a default template parameter value;

- responsive to a determination that the histogram contains more than one peak, determining if the default template parameter value is within one standard deviation of a first histogram peak;

- responsive to a determination that the default template parameter value is within one standard deviation of the first histogram peak, updating the default template parameter value using a data for the first histogram peak which is within one standard deviation of the default template parameter value, and analyzing any histogram peak that is not within one standard deviation of the default template parameter value;

- responsive to a determination that the default template parameter value is not within one standard deviation of any of the histogram peaks, analyzing a second histogram peak, and determining if a standard deviation for the second histogram peak is less than a template creation threshold; and

- responsive to a determination that the standard deviation for the analyzed second histogram peak is less than the template creation threshold, creating the new return on investment template using an average determined by analyzing the second histogram peak, wherein the new return on investment template calculates the amount of money the customer will spend for the process upgrade;

wherein the effectiveness factor of a template is based at least upon the accuracy of the applications in the template, the accuracy of the computers in the template, the accuracy of the customer's information technology infrastructure, and whether the customer made a purchase.

Each claim has been amended to recite "according to a plurality of effectiveness factors of each the modified templates, and wherein the plurality of effectiveness factors are calculated by determining an application accuracy, a computer accuracy, and an information technology infrastructure accuracy." Support for the amendments is found in paragraph [0038] of the specification. Applicants submit that the art of record, individually or in combination, is silent as to the limitation.

In regard to the preamble, the Examiner stated:

In this case the preamble of the independent claim 49 is: "A computer implemented method for creating a new return on investment template from a default template and a plurality of modified templates, the new return on investment template calculating an amount of money a customer will spend for process upgrade"; and the primary applicant's arguments is that Shibuya does not disclose, from a default template and a plurality of modified templates, the new return on investment template calculating an amount of money a customer will spend for process upgrade; the Examiner notices that the applicant arguments falls entire in the preamble of the claim 49, and the preamble is generally not accorded any patentable weight for a claim.

Applicants disagree with the Examiner for at least two reasons. First, the elements of the amended preamble, "for creating a new return on investment template from a default template and a plurality of modified templates in order to calculate an amount of money a customer will spend for a process upgrade," are recited in the body of the claim. For example, the limitation "wherein the new return on investment template calculates the amount of money the customer will spend for the process upgrade," recites the new return on investment template, the amount of money, the customer, and the process upgrade, all of which were introduced in the preamble, and then cited in the main body of the claim.

In regard to the element "developing a data list from the plurality of modified templates and the modified templates' effectiveness factors, wherein the data in the modified templates is weighted according to the modified templates' effectiveness factors," the Examiner stated the following:

With respect to claim 49, Shibuya et al. (hereafter Shibuya) teaches a computer implemented method for creating a new return on investment template from a default template and a plurality of modified templates, the new return on investment template calculating an amount of money a customer will spend for process upgrade, the method comprising: developing a data list from the plurality of modified templates (see page 8 paragraph [0098], the addition is performed at least once and the result is stored as a pattern information) and the modified templates effectiveness factors, wherein the data in the modified templates is weighted according to the modified templates' effectiveness factors (see page 5 paragraph [0068], in addition to the automatically created geometric template patterns 705, a user registers a template pattern 707 in advance and a pattern image 706 having the highest matching score selected; and see page 6 paragraph[0080], calculating the matching score between the high density area image 704 and the template pattern image 705, FIG. 15);

Final Office Action dated December 15, 2009, page 1-2.

The Examiner's citations to Shibuya et al. do not explicitly or inherently disclose the claim limitation. The Examiner cites paragraphs [0098], [0068] and [0080] which are set forth below:

[0098] Pattern information addition means 301 adds information associated with a pattern such as pattern position, size, shape, importance, and special matter to a plurality of geometric template patterns automatically created and the user registration template pattern. The pattern information addition means 301 consists of a section for adding default information to the geometric template pattern and a section for manually adding information to the user registration template pattern. The pattern information addition is per US 2004/0064269 A1 formed offline. The addition is performed at least once and the result is stored as a pattern information file 311 in storage means 302 such as a hard disc.

[0068] According to another embodiment of the present invention, in addition to the automatically created geometric template patterns 705, a user registers a template pattern 707 in advance and a pattern image 706 having the highest matching score is selected. The pattern image 706 is superimposed on the wafer map 103 and defects contained in the pattern portion are detected as ring and blob type defects.

[0080] Next, explanation will be given on the method for calculating the matching score between the high density area image 704 and the template pattern image 705 with reference to FIG. 15. Each pixel value of the high density area image 704 is compared to the pixel value of the identical address of the template pattern image 705. If matched, +1 is obtained and if not matched, -1 is obtained. The comparison results of all the pixels are totaled and the obtained value is used as the matching score. In FIG. 15, the high density area image 704 and the template

pattern image parts 705a and 705b are shown by expressing the pixel value 1 by black and pixel value 0 by white. 708a and 708b show unmatched portions between the high density area image 704 and the template pattern images 705a and 705b by black. That is, in these images, the pixel value of the white portion is 1 and the pixel value of the black portion is -1. The total of all the pixel values is the matching score. When 708a is compared to 708b, 708a has a smaller black area and accordingly, 705a has a higher matching score with the high density area image 704 than 705b.

The claim limitation includes a (1) “data list,” (2) a plurality of “modified templates,” (3) “modified template effectiveness factors, and (4) “weighting the data according to the modified templates effectiveness factors.” Applicants submit that Shibuya et al. is silent as to these limitations. First, the limitations are not expressly disclosed. The limitations are not expressly disclosed because Shibuya et al. discloses geometric template patterns that are automatically created. Shibuya et al. further disclose that “a pattern image 706 having the highest matching score is selected,” and that the “pattern image 706 is superimposed on the wafer map 103 and defects contained in the pattern portion are detected as ring and blob type defects.” Shibuya et. al. further discloses a “method for calculating the matching score between the high density area image 704 and the template pattern image.” But none of these disclosures have anything to do with the limitations of claim 49.

Second, the limitations are not inherently disclosed. The limitations are not inherently disclosed because the Examiner has not shown that the limitations of claim 49 would necessarily follow from the disclosures of Shibuya et al. set forth above. Indeed, such a showing cannot be made because of the vast difference between the subject matter of Shibuya et al. and claim 49. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is

not sufficient.' " In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

In regard to the element "plotting the data list on a histogram, the histogram comprising an orthogonal axis for each parameter in the default template," the Examiner stated:

plotting (see page 3 paragraph [0052], when a straight line passing through point P1 on the xy space is plotted) the data list on a histogram (see page 5 paragraph [0072], a histogram of the area of the Voronoi cell is calculated), the histogram comprising an orthogonal axis for each parameter in the default template (see FIGS. 6, 7, xy space with orthogonal axis x and y).

Final Office Action dated December 15, 2009, page 2.

The Examiner has merely cited to a use of the word "plotting." He has not shown plotting from a "data list" nor has he shown how the cited art is directed to the elements of claim 49. Therefore, the limitation is not expressly disclosed. Further, the element cannot be inherently disclosed because it cannot be shown that the claim element necessarily follows from the cited art. (See discussion of inherency *supra*).

In regard to the element, "analyzing each parameter by performing steps comprising: determining if the histogram contains more than one peak for a parameter," the Examiner stated:

... [A]nalyzing each parameter by performing steps comprising; determining if the histogram contains more than one peak for a parameter (see page 3 paragraph [0048], the maximum voting value (x, y) is detected as a center candidate. Peak sharpness is checked).

Final Office Action dated December 15, 2009, pages 1-2.

Shibuya states the following:

[0048] Next, the maximum voting value (x, y) is detected as a center candidate (S502). Peak sharpness is checked by comparing with the surrounding values and if the peak is not sharp, the processing is terminated (S503). If the peak is sharp, by using the maximum voting value (x, y) as the origin, all the defect coordinates are converted into (r,  $\theta$ ) so as to create a polar coordinates converting image

showing the defect density on the  $r\theta$  space as a gray level (S504). Projection onto the  $r$  axis is calculated and the  $r$  of the maximum projection value is found (S505).

The Examiner has merely cited to a use of the word “analyzing.” He has not shown analyzing “each parameter” (where “each parameter” refers to parameters in a “default template.” Moreover, the analysis is for an orthogonal axis for each parameter in the default template. Shibuya, paragraph [0048] discusses a “maximum voting value ( $x,y$ ).” The Examiner has not shown how the cited art is directed to the elements of claim 49. By finding similar words, the Examiner has shown only that a portion of the element may be disclosed, but in a different context from that of claim 49. Therefore, the limitation is not expressly disclosed. Further, the element cannot be inherently disclosed because it cannot be shown that the claim element necessarily follows from the cited art. (See discussion of inherency *supra*). The claim element cannot be shown to necessarily follow from the cited art because the teachings of Shibuya cannot be substituted into the elements of claim 49. If they were substituted into the elements of claim 49, the claim would not perform the operations claimed because Shibuya is directed to a different calculation.

In regard to the elements, “responsive to a determination that the histogram contains one peak, updating a default template parameter value,” and “responsive to a determination that the histogram contains more than one peak, determining if the default template parameter value is within one standard deviation of a first histogram peak,” the Examiner stated:

...[R]esponsive to a determination that the histogram contains one-peak, updating a default template parameter value (see page 7 paragraph [0094], the pattern position, size, and shape of the geometric template pattern 705 are roughly classified according to a certain rule and default information is added); responsive to a determination that the histogram contains more than one peak (see page 3 paragraph [0048], the maximum voting value ( $x, y$ ) is detected as a center candidate. Peak sharpness is checked),

Final Office Action dated December 15, 2009, pages 2-3.

The Examiner’s statement does not establish that the element is explicitly disclosed. The Examiner’s argument appears to be that in Shibuya, when “a determination that the histogram contains more than one peak (see page 3 paragraph [0048], the maximum voting value ( $x, y$ ) is detected as a center candidate,” and “peak sharpness is checked.” Applicants are unclear how detecting the maximum voting value ( $x,y$ ) as a center candidate” discloses “updating a default



template parameter value.” Applicants submit that it does not because it cannot be said to explicitly disclose the limitation. In addition, the Examiner has not made any argument to show that the claim limitation must necessarily follow from the disclosure of Shibuya as required to establish inherency.

In regard to the limitation, “responsive to a determination that the default template parameter value is within one standard deviation of the first histogram peak, updating the default template parameter value using a data for the first histogram peak which is within one standard deviation of the default template parameter value, and analyzing any histogram peak that is not within one standard deviation of the default template parameter value,” the Examiner stated:

... [R]esponsive to a determination that the default template parameter value is within one standard deviation of the first histogram peak (see page 6 paragraph [0085], standard deviation of pixel values inside of the pattern), updating the default template parameter value using a data for the first histogram peak which is within one standard deviation of the default template parameter value (see page 7 paragraph [0094], the pattern position, size, and shape of the geometric template pattern 705 are roughly classified according to a certain rule and default information is added), and analyzing any histogram peak (see page 3 paragraph [0048], the maximum voting value (x, y) is detected as a center candidate. Peak sharpness is checked) that is not within one standard deviation of the default template parameter value (see page 6 paragraph [0085], standard deviation of pixel values outside of the pattern).

Final Office Action dated December 15, 2009, page 3.

Shibuya states the following:

[0085] Op' 0b;) standard deviation of pixel values of gray level image inside and outside the pattern

[0086] The C is compared to a predetermined threshold value and if the C is equal to or below the threshold value, it is judged that there is no pattern. Moreover, when the modal value in the histogram obtained in 51202 is lower than a predetermined threshold value, no more processing is performed and it is judged that there is no pattern. When the former threshold value is set to a small value, it is possible to detect a patter of a smaller density difference. Moreover, when the latter threshold value is set to a small value, it is possible to detect a pattern of a smaller defect density. If these threshold values can be specified by a user, the user can adjust the sensitivity.

[0094] The information added includes pattern position, size, shape, importance, and special matter. The pattern position, size, and shape of the geometric template

patter 705 are roughly classified according to a certain rule and default information is added. For the blob type pattern, the pattern position is classified, for example, upper right, top, upper left, right, center, left, lower right, bottom, and lower left. The size is classified, for example, into large, intermediate, and small. The shape is a blob. For example, FIG. 14B has a small size blob pattern at the upper left, FIG. 14C has an intermediate size blob pattern at the right, and FIG. 14D has a large size blob pattern at the center. As for the ring type pattern, it is a radius-size quarter ring pattern at the upper right. It should be noted that even if the pattern derives from a blob type pattern, the pattern is handled as a ring pattern if the pattern consists of only one outer row, and even if the pattern derives from a ring pattern, the pattern is handled as a blob pattern if the innermost circle is contained.

Applicants are unclear how the above cited sections of Shibuya disclose “updating the default template parameter value using a data for the first histogram peak which is within one standard deviation of the default template parameter value, and analyzing any histogram peak that is not within one standard deviation of the default template parameter value.” The Examiner has merely found some similar words in a reference directed to an entirely different operation. Applicants submit that Shibuya cannot be said to explicitly disclose the limitation. In addition, the Examiner has not made any argument to show that the claim limitation must necessarily follow from the disclosure of Shibuya as required to establish inherency.

In regard to the element, “responsive to a determination that the default template parameter value is not within one standard deviation of any of the histogram peaks, analyzing a second histogram peak, and determining if a standard deviation for the second histogram peak is less than a template creation threshold,” the Examiner stated:

... [R]esponsive to a determination that the default template parameter value is not within one standard deviation (see page 6 paragraph [0085], standard deviation of pixel values inside of the pattern) of any of the histogram peaks, analyzing a second histogram peak (see page 3 paragraph [0048], the maximum voting value (x, y) is detected as a center candidate. Peak sharpness is checked), and determining if a standard deviation for the second histogram peak is less than a template creation threshold (see page 6 paragraph [0086], the C is compared to a predetermined threshold value and if the C is equal to or below the threshold value, it is judged that there is no pattern);

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The Examiner cites to Shibuya, paragraph [0086] to disclose “a template creation threshold.” Shibuya, [0086] states the following:

[0086] The C is compared to a predetermined threshold value and if the C is equal to or below the threshold value, it is judged that there is no pattern. Moreover, when the modal value in the histogram obtained in 51202 is lower than a predetermined threshold value, no more processing is performed and it is judged that there is no pattern. When the former threshold value is set to a small value, it is possible to detect a pattern of a smaller density difference. Moreover, when the latter threshold value is set to a small value, it is possible to detect a pattern of a smaller defect density. If these threshold values can be specified by a user, the user can adjust the sensitivity.

Applicants submit that the Examiner has merely found similar words, i.e. “predetermined threshold” in a reference directed to an entirely different operation. The reference does not disclose “a template creation threshold.” Therefore, Applicants submit that Shibuya cannot be said to explicitly disclose the limitation. In addition, the Examiner has not made any argument to show that the claim limitation must necessarily follow from the disclosure of Shibuya as required to establish inherency.

In regard to the limitation, “responsive to a determination that the standard deviation for the analyzed second histogram peak is less than the template creation threshold, creating the new return on investment template using an average determined by analyzing the second histogram peak, wherein the new return on investment template calculates the amount of money the customer will spend for the process upgrade,” the Examiner stated:

responsive to a determination that the standard deviation for the analyzed second histogram peak (see page 6 paragraph [0085], standard deviation of pixel values inside of the pattern) is less than the template creation threshold (see page 6 paragraph [0086], the C is compared to a predetermined threshold value and if the C is equal to or below the threshold value, it is judged that there is no pattern), Shibuya does not teach; creating the new return of investment template But Lau et al. (hereafter Lau) teaches in a method and system for optimizing software upgrades that, the upgrade analysis system 150 preferably further qualifies the at-risk binaries 190 into additional subset that facilitate the determination of whether to proceed with a software upgrade based on return on investment (ROI), return on assets (ROA), total cost of ownership (TCO), and other financial and technical considerations (see Lau; col. 9, lines 32-41). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Shibuya to include a upgrade analysis system as taught by Lau, because the

upgrade analysis system of Lau allows to proceed with a software upgrade based on return on investment (ROI), as desired.

Final Office Action dated December 15, 2009, page 4.

Applicants submit that Shibuya fails to disclose the portion of the limitation for which the Examiner cites Shibuya for all the reasons set forth above. Lau, cited by the Examiner, fails to remedy the deficiency. Lau does not explicitly disclose the claim limitation. Moreover, the Examiner has not established that the claim limitation necessarily follows from the disclosure of Lau in combination with Shibuya. Furthermore, Lau cannot be substituted into Shibuya to arrive at the limitations of claim 49 because the substitution would not work, and even if it did, it would not perform the functions of claim 49.

In regard to the limitation “wherein the effectiveness factor of a template is based at least upon the accuracy of the applications in the template, the accuracy of the computers in the template, the accuracy of the customer’s information technology infrastructure, and whether the customer made a purchase,” the Examiner stated:

Shibuya does not teach; wherein the effectiveness factor of a template is based at least upon the accuracy of the applications in the template, the accuracy of the computers in the template, the accuracy of the customer's information technology infrastructure, and whether the customer made purchase. But Lau teaches that, the upgrade analysis system 150 preferably further qualifies the at-risk binaries 190 into additional subset that facilitate the determination of whether to proceed with a software upgrade based on return on investment (ROI), return on assets (ROA), total cost of ownership (TCO), and other financial and technical considerations (see Lau; col. 9, lines 32-41). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Shibuya to include an upgrade analysis system as taught by Lau, because the upgrade analysis system of Lau allows to proceed with a software upgrade based on return on investment (ROI), return on assets (ROA), total cost of ownership (TCO), and other financial and technical considerations, as desired.

Final Office Action, dated December 15, 2009, page 5.

Applicants submit that Shibuya fails to disclose the portion of the limitation for which the Examiner cites Shibuya for all the reasons set forth above. Lau, cited by the Examiner fails to remedy the deficiency. Lau does not explicitly disclose the claim limitation. Moreover, the Examiner has not established that the claim limitation necessarily follows from the disclosure of

Lau in combination with Shibuya. Furthermore, Lau cannot be substituted into Shibuya to arrive at the limitations of claim 49 because the substitution would not work, and even if it did, it would not perform the functions of claim 49.

Furthermore, an explicit analysis must be provided in an obviousness rejection. In combining references, an explicit analysis is required to combine or modify references. The Supreme Court has stated the following:

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit. See *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006). [R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.). As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

*KSR Int'l v. Teleflex Inc.* 127 S. Ct. 1727, 1741 (2007). Conclusory statements are insufficient to support obviousness rejections. In particular, “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” See *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006).

The Examiner stated the following in combining the cited references:

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Shibuya to include an upgrade analysis system as taught by Lau, because the upgrade analysis system of Lau allows to proceed with a software upgrade based on return on investment (ROI), return on assets (ROA), total cost of ownership (TCO), and other financial and technical considerations, as desired.

As can be seen, an express analysis has not been provided in the Examiner’s reasons for combining the references. The statements made by the Examiner do not provide reasons as required in the Supreme Court guidance on combining references in the KSR case. Instead, the Examiner has only provided statements that are conclusory or reciting some desired goal. These

conclusions and desired goals have not been supported with any explicit analysis or articulated reasoning with some rationale underpinnings to support the conclusions or goals for combining the elements in these two references in the manner proposed by the Examiner. Further, even if these conclusory statements or goals could be considered "reasons", they do not have any articulated reasoning with some rational underpinning to support the Examiner's assertion of obviousness.

The Examiner has merely offered a goal or desire to "proceed with a software upgrade based on return on investment (ROI), return on assets (ROA), total cost of ownership (TCO), and other financial and technical considerations, as desired." To meet this goal, the Examiner states it would have been obvious to combined Shibuya and Lau. Nowhere, however, has the Examiner gone beyond this conclusion or desired goal to explain sufficiently why one of ordinary skill in the art would have technically combined these two references, or whether such a combination would even be technically possible.

Therefore, the rejection of claim 49 under 35 U.S.C. § 103 has been overcome.

## **II. Conclusion**

It is respectfully urged that the subject application is patentable over the cited prior art and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: March 16, 2009

Respectfully submitted,

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